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## REMARKS

Claims 12-26 stand pending in the present application. By this Amendment, Applicant has amended claim 12, added claims 25 and 26 and canceled claims 1-11 without prejudice or disclaimer. Applicant submits that the present application is now in condition for allowance based on the discussion which follows.

Claims 12-24 were objected to for failing to providing proper antecedent basis for the limitation "the workpiece support table" in claim 12, line 5. By this Amendment, Applicant has amended claim 12 to provide antecedent basis for the workpiece support table thereby obviating this objection.

Claims 12-24 were rejected under 35 U.S.C. §112, second paragraph. In particular, the Examiner noted that the language "on the side of the workpiece located opposite the marking tool" was unclear in claim 12 and further the Examiner was unclear as to the location of the counter-support with respect to the marking tool and workpiece. By this Amendment, Applicant has amended claim 12 to more clearly recite the present invention. In particular, claim 12 has been amended to more clearly define that the counter-support is located on a side of the workpiece opposite the surface being marked by the apparatus. Accordingly, claim 12 more clearly defines that during use, a workpiece is located between the marking tool and the counter-support so that the marking tool marks a marking surface while the counter-support is disposed on a side of the workpiece opposite the marking surface. Subject matter basis for this amendment is found in the specification and in Figure 1 as filed which depicts workpiece 12 located between the marking tool with 34 and the counter-support 46. Therefore, the amendment to claim 12 does not constitute new matter.

Claims 12, 20 and 21 were rejected under 35 U.S.C. §102(b) as being anticipated by Hirate, U.S. Patent No. 5,775,215. The Examiner alleges that Hirate teaches an apparatus for marking a workpiece which includes a marking tool 79 and a counter-support 7. Further, the Examiner alleges that the marking tool 79 can be fixed in place in a punch holder 77 or a holder at the workpiece support table of a punch press.

Contrary to the Examiner's assertions, Hirate fails to teach or suggest the claimed marking tool which can be fixed in a punch holder or holder of a punch press and Hirate fails to teach or suggest a counter-support. The claimed marking tool can be fixed in a punch holder or a holder of a workpiece support table of a punch press. Further, the counter-support can be fixed in place relative to the workpiece and is disposed on a side of the workpiece opposite a surface to be marked.

Referring to the specification to provide a better understanding of the claimed invention but to in no way limit the scope of the claimed invention, the counter-support supports a workpiece during operation of the present invention. See paragraph [0046]. Thus, the counter-support counters the effects of the marking tool by opposing the force of the marking tool which is pressed into the workpiece. In one specific embodiment, advantageously, the counter-support is aligned with the marking tool.

By this Amendment, Applicant has added claims 25 and 26. Claim 25 explicitly recites that the counter-support is aligned with the marking tool. Claim 26 recites that the counter-support can be fixed in place on the punch holder or on the support table. Subject matter support for claims 25 and 26 can be found in the specification as filed in

paragraphs [0018] and [0041], and therefore claims 25 and 26 do not constitute new matter.

Hirate fails to teach a marking tool which can fit into a punch holder or a holder of a workpiece support table of a punch press. On the contrary, the device of Hirate clearly teaches its marking tool which includes stylist 77 and marking tip 79 as being part of a completely separate marking tool assembly 83. Moreover, Hirate clearly teaches two separate devices, a marking apparatus 29 and a punch press 83 (see Figures 1 and 3, and column 6, lines 19-21). Accordingly, marking tool 79 is inserted into stylist 77 of marking apparatus 83. Hirate fails to teach or suggest that marking tool 79 is inserted into punch press 83, let alone, a punch holder, such as turret disk 3.

Moreover, contrary to the Examiner's assertion, stylist 77 fails to read on or anticipate a punch holder of a punch press to which the claimed marking tool is configured to be disposed. A punch holder of a punch press is a specific apparatus which one of ordinary skill in the art would readily appreciate as a part of a punch press designed to fit various tool parts including various punches. Stylist 79 fails to be a punch holder let alone part of a punch press.

Since the marking tool 79 is not a punch holder, nor is marking tool 79 disposable in a punch press as claimed, Hirate fails to anticipate the claimed marking tool.

Further, Hirate fails to teach or suggest any counter-support which is disposed on a side of a workpiece opposite the side/surface being marked. ~~Contrary to the~~ Examiner's assertion, table 7 fails to disclose the claimed counter-support. A counter-support is a specific term of art. In the context of the claimed invention, it would be

readily apparent to one of ordinary skill in the art that the claimed counter-support would support a workpiece against the force of the marking tool during a marking operation. Hirate's table 7 fails to teach or suggest a counter-support as that term would be understood by one skilled in the art.

Therefore, since Hirate fails to teach or suggest a marking tool which is adapted to fit into a punch holder and Hirate fails to teach or suggest a counter-support, Hirate fails to anticipate the claimed invention. Based on the foregoing, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. §102(b) rejection to claims 12, 20 and 21.

Claims 12, 13 and 20 were rejected under 35 U.S.C. §102(b) as being anticipated by Andou. The Examiner alleges that Andou teaches an apparatus for marking a workpiece. Applicant respectfully submits that Andou, which is directed to a paper printer is not analogous to the claimed apparatus which is directed to a marking tool adapted to fit into a punch holder of a punch press. Therefore, Applicant respectfully submits that claims 12, 13 and 20 are not anticipated by Andou under 35 U.S.C. §102(b).

Claims 18 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hirate in view of Canning. The Examiner alleges that it would have been obvious for one of ordinary skill in the art to use a diamond tool tip of Canning in the marking tool of Hirate to make the claimed invention obvious.

~~Contrary to the Examiner's allegation, it would not have been obvious for one of~~  
ordinary skill in the art to combine the dissimilar and completely non-analogous art of Hirate with Canning. Hirate is directed to a machine tool system coupling a marking

apparatus and a turret punch press. Canning is directed to a semiconductor cleaving device. One of ordinary skill in the art would not combine the art of semiconductor manufacturing with a marking tool and punch press. Moreover, Hirate, as discussed above, fails to teach or suggest the claimed marking tool or counter-support. Canning fails to make up the deficiencies of Hirate. Therefore, since Hirate and Canning are non-analogous art and their individual and combined teachings fail anticipated claimed elements, Applicant respectfully submits that claims 18 and 19 are not unpatentable under 35 U.S.C. §103 in view of Hirate and Canning.

The Examiner rejected claim 18 as being unpatentable over Andou in view of Sawa. Contrary to the Examiner's assertion, it would not have been obvious to one of ordinary skill in the art to combine this dissimilar and non-analogous art. Andou and Sawa are directed to the non-analogous art of paper printers whereas the present invention is directed to a marking tool disposable in a punch holder of a punch press. One skilled in the art of punch presses would not turn to the art of paper printers. Therefore, the claimed invention is not anticipated nor made obvious by Andou in view of Sawa.

Claims 22 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hirate in view of Rohr. Contrary to the Examiner's assertion, it would not have been obvious for one of ordinary skill in the art to combine the dissimilar and non-analogous teaching of Hirate with Rohr. Hirate is directed to an apparatus for marking a workpiece whereas Rohr is directed to a sewing machine. One of ordinary skill in the art wishing to improve upon an apparatus for marking a workpiece would not combine the art of a marking tool of Hirate with a sewing machine of Rohr. Accordingly, contrary

to the Examiner's assertion, it would not have been obvious to modify Hirate to comprise a ball point, roller point, felt point or grease pencil. Therefore, claims 22 and 23 are not obvious under 35 U.S.C. §103(a) in view of Hirate and Rohr.

Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hirate in view of Keller. As previously discussed, with regard to the rejection of claim 12 as being anticipated by Hirate, claim 24 which depends from claim 12 is not taught or suggested from Hirate for at least the same reasons discussed above. Keller fails to make up the deficiencies of Hirate.

Moreover, claim 24 recites that the marking tool comprising plastic or brass. Contrary to the Examiner's assertion, it would not been obvious to combine a marking tool of a steel workpiece of Hirate with the dissimilar and non-analogous printer art of Keller. A mechanical press such as Hirate is not analogous to a paper printer of Keller. Therefore, it is inappropriate to combine the non-analogous and dissimilar arts in a 35 U.S.C. §103 rejection. Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. §103(a) rejection of claim 24 as being unpatentable over Hirate in view of Keller.

Applicant gratefully appreciates the Examiner's indication of allowable subject matter of claims 14-17. In view of the foregoing, Applicant respectfully submits that all pending claims, claims 12-26, are allowable over the art based on the previous discussion.

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By this Amendment, Applicant has corrected a clerical oversight which occurred during the preparation of this application. Applicant has amended paragraph [0041] of the specification to properly identify the element 46 as the counter support. This

correction is obvious from the rest of the specification and from Figure 1 which clearly shows that element 46 is the counter-support means.

In view of the foregoing, Applicant respectfully submits that the present application is now in condition for immediate allowance. Should the Examiner not find the application to be in condition for immediate allowance, the Examiner is invited to call the undersigned at the number below.

Respectfully submitted,

Date: 13 January 2003

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## ATTACHMENT B

### Marked Up Replacement Paragraphs

*At the following locations, a marked up copy of the replaced paragraph is provided.*

*Page 10, paragraph 41, lines 13-16.*

In the exemplary embodiment represented, the workpiece 12 is a sheet metal plate which rests on a ~~tool holder~~ counter support 46 with a rotatably seated ball 48, wherein the contact point between the workpiece 12 and the ball 48 lies exactly in alignment with the inscribing element 34.

## ATTACHMENT D

### Marked Up Replacement Claims

*Following herewith is a marked up copy of each rewritten claim together with all other pending claims.*

12. (Amended) An apparatus for marking a sheet-shaped workpiece, comprising at least one marking tool and at least one counter-support ~~on the side of the workpiece~~ located opposite the marking tool, the apparatus being configurable with the workpiece disposed between the marking tool and the counter support, wherein the marking tool has a tool tip, which can be pressed onto or into a marking surface of the workpiece against a restoring force of an elastic element, the marking tool being fixed in place on a punch holder or ~~the a holder at the of a~~ workpiece support table of a punch press, and wherein the counter-support can be fixed in place ~~on the other side relative to the workpiece and disposed on a side of the workpiece opposite the marking surface.~~

13. The apparatus according to claim 12, wherein the counter-support includes at least one rotatable support roller or support ball for the movable support of the workpiece.

14. The apparatus according to claim 12 wherein the marking tool includes rotatable support rollers or support balls, seated in an elastically spring-loaded manner.

15. The apparatus according to claim 14, wherein spring travel of the support rollers or support balls is greater than spring travel of the tool tip.

16. The apparatus according to claim 15, wherein, in a rest position, the tool tip projects upwardly less than the support rollers or support balls, but wherein the support rollers or support balls are resiliently retractable to a lower position than the tool tip.

17. The apparatus according to claim 14, wherein resiliency of the elastic elements of the support rollers is less than resiliency of the elastic element of the tool tip.

18. The apparatus according to claim 12, wherein the tool tip is selected from the group consisting of diamond, boron nitride or a hard alloy.

19. The apparatus according to claim 12 wherein the tool tip is cone-shaped.

20. The apparatus according to claim 12, including an adjustable support associated with the marking tool, by means of which the position of the tool tip and/or the prestress of its restoring spring can be adjusted.

21. The apparatus according to claim 12, wherein the marking tool comprises a tip capable of penetrating the surface of the workpiece to a predetermined depth to inscribe a mark.

22. The apparatus according to claim 12, wherein the marking tool comprises an ink point for writing a marking on the surface of the workpiece.

23. The apparatus according to claim 22, wherein the ink point comprises a ball point, a roller ball point, a felt tip or a grease pencil.

24. The apparatus according to claim 12, wherein the marking tool comprises brass or plastic.

25. (New) The apparatus according to claim 12, wherein the counter-support is aligned with the marking tool.

26. (New) The apparatus according to claim 12, wherein the counter-support can be fixed in place on the punch holder or the support table.